

REMARKS

In the Office Action mailed July 25, 2007 from the United States Patent and Trademark Office, the Examiner objected to claims 1, 6, 7, 8, 12, and 13 as containing informalities. The Examiner rejected claims 1-13 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,804,787, and provisionally rejected claims 1-13 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of copending U.S. Application No. 11/057,097. The Examiner rejected claims 1-6 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,028,049 to Shelton (hereinafter "Shelton") in view of U.S. Patent Application Publication No. 2004/0139025 to Coleman (hereinafter "Coleman") and rejected claims 7-13 under 35 U.S.C. § 103(a) as being unpatentable over Shelton in view of U.S. Patent Application Publication No. 2002/0013519 to Adams et al. (hereinafter "Adams").

Applicant therefore respectfully provides the following:

Claims 1, 3, and 7-9 are currently amended.

Claims 14-20 are new.

Consideration of Japanese Reference Cited in IDS:

In the Office Action, the Examiner indicated that Japanese Reference JP 2001005833 was not considered because an English translation is required. 37 C.F.R. § 1.98(a)(3)(ii) indicates that a copy of a translation of the foreign-language document is only required if it is within the possession, custody, or control of, or is readily available to any individual designated in 37 C.F.R. § 1.56(c). The Japanese reference was cited in a foreign examination report without including a copy of a translation in English. Applicant does not have a copy of the foreign

reference in English. In addition, it appears that the Japanese reference is a priority document for the U.S. patent cited by Applicant in the same IDS. (See cover sheet of U.S. Patent No. 6,754,665 to Futugami, which indicates that priority was claimed to Japanese patent application 11-177820, the cited, but not considered reference. In addition, a comparison of the Figures from both references shows apparently-identical Figures.) In the foreign examination report, the Japanese reference was cited jointly with the apparently-corresponding U.S. reference, and no explanation of the relevance of the foreign reference outside of the apparently-corresponding U.S. reference was given. Applicant therefore respectfully believes that the Japanese reference is merely cumulative of the information already considered.

Claim Objections:

In the Office Action, the Examiner objected to claims 1, 6, 7, 8, 12, and 13 as containing informalities. Applicant has made the suggested changes to claims 1, 7, and 8, and respectfully requests withdrawal of the objections to those claims.

Regarding the objections to claims 6, 12, and 13, the Office Action suggested that “a database service” be changed to “said database service,” indicating that it appeared that the same database service appeared to be referred to in claims 4 and 10. Regardless of whether the same database service is claimed in claims 6, 12, and 13 as in claims 4 and 10 (and 12, in the case of claim 13), Applicant respectfully submits that it would be improper to amend the claims to recite “said database service” as claims 6, 12, and 13 all depend from one of claims 1 and 7, and therefore do not incorporate the limitations of claims 4 and 10. In such a case, “said database service” would have a lack of antecedent basis if used in claims 6, 12, and 13. Applicant therefore respectfully requests withdrawal of the objections to claims 6, 12, and 13.

Double Patenting Rejections:

In the Office Action, all claims were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,804,787, and were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of copending U.S. Patent Application No. 11/057,097.

Regarding claims 1-24 of copending U.S. Patent Application No. 11/057,097, M.P.E.P. § 804(I)(B)(1) states that

If a “provisional” nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.

Applicant respectfully submits that the present application was filed earlier than co-pending Application No. 11/057,097 and that the current amendment addresses every other rejection in the Office Action and places the application in a condition for allowance. Applicant therefore respectfully requests removal of the provisional nonstatutory obviousness-type double patenting rejection and issuance without further action by Applicant.

Regarding claims 1-19 of U.S. Patent No. 6,804,787, M.P.E.P. § 804(II)(B)(1) indicates that the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103 are employed when making an obvious-type double patenting analysis. Therefore, the factual inquiries that should be considered in making a double patenting rejection include: 1) determine the scope and content of the prior art, 2) ascertain the differences between the prior art and the claims at issue, and 3) determine the level of ordinary skill in the art. The analysis

differs from the typical § 103 analysis in that the analysis is based solely on the claims of the issued patent, and not on the patent's disclosure. (M.P.E.P. §§ 804(II)(B)(1) and 804(III).)

Applicant respectfully submits that the claims of the instant application are not obvious variants of the claims of the cited patent when considered in light of the requirements set forth above.

Regarding the factual inquiries of determining the scope and content of the cited patent and ascertaining the differences between the cited patent and the claims at issue, Applicant provides below a side-by-side comparison between independent claim 1 of the instant application and independent claim 1 and dependent claim 3 of the cited patent. As the Office Action did not provide a more-detailed claim-by-claim analysis comparing what was allegedly claimed in the cited patent against the claims of the instant application, Applicant provides this comparison between the instant claims and claims 1 and 3 of the cited patent, believing that claims 1 and 3 appear to be representative of the scope of the claims of the cited patent. All compared claims are method claims.

Instant Application:

1. A method for controlling a release of personal information comprising:

depositing some personal information regarding an individual with an enterprise/server;

obligating organizations that possess additional personal information regarding said individual to not disclose that additional personal information without authorization from said enterprise/server; and

instructing said enterprise/server to not release said some personal information held on the enterprise/server and to not authorize release of said additional personal information at the obligated organizations without receiving authorization from said individual.

Patent 6,804,787

1. In a system that includes a computer device, a method for managing healthcare data in compliance with regulated privacy, security, and electronic transaction standards, the method comprising:

receiving from a requestor a request for healthcare information relating to a patient, wherein any request is received through a single point of entry regardless of whether the request is from a requestor internal or external to a given healthcare facility;

retrieving the requested healthcare information;

assembling a report, wherein the report includes:

the requested healthcare information;

any comments of the patient received at a gatekeeper system regarding the requested healthcare information; and

an audit trail; and

transmitting a copy of the report to the requestor through a single point of exit regardless of whether the request was from a requestor internal or external to the given healthcare facility.

3. A method as recited in claim 1, further comprising the step for determining whether patient authorization exists for responding to the request, wherein if authorization from the patient has not been obtained, performing the step for obtaining authorization from the patient to provide the requested healthcare information.

As may be readily appreciated from the above comparison, there are significant differences between the claimed invention of claim 1 from the instant application and claims 1

and 3 of the cited patent. Specifically, claim 1 of the instant application recites a method for controlling a release of personal information, while claims 1 and 3 of the cited patent claim a method for managing healthcare data in compliance with certain standards, and does not recite controlling the release of information. Indeed, claim 1 of the instant application requires obligating organizations that possess additional personal information regarding the individual to not disclose that additional personal information without authorization from the enterprise/server and instructing the enterprise/server to not release the personal information held on the enterprise/server and the additional personal information at the obligated organizations without receiving authorization from the individual. In contrast, no such controls on the release of information that extend beyond a single entity to other organizations are disclosed in claims 1 or 3 of the cited patent.

Instead, claims 1 and 3 of the cited patent specifically claim that any disclosure is made through a single point of entry/exit and claims nothing regarding any additional organizations. The Office Action asserted that the enterprise/server of claim 1 of the instant application corresponds to the single point of entry/exit of the cited patent, and refers to page 20 paragraph 1 of the instant application for support of the contention of correspondence. However, even as summarized in the Office Action, the portion of the instant specification clearly shows the differences between the claimed inventions of the instant application and the cited patent. The cited passage indicates that in the described embodiment of the presently-claimed invention, each organization contractually agrees to first contact the enterprise-server 102 before releasing any information about the user so the server 102 can inform and request the user 100 if the request to release confidential information is acceptable or not. What the Office Action ignores is the final portion of the paragraph, which indicates that the enterprise/server instructs the

organization to release the information to the third party 112, and does not release the information itself. This may be seen by reference to Figure 2, which is the figure being described by the cited paragraph. (See page 19, last paragraph.)

Therefore, for at least these reasons, claim 1 of the instant application is not anticipated or made obvious by the claims of the cited patent as the invention claimed by claim 1 of the instant application provides a method for controlling release of personal information from the enterprise/server itself and also from additional organizations. Such limitations are not claimed by any of the claims of the cited patent. Claims 2-6 of the instant application add additional limitations to claim 1 of the instant applications, and are therefore similarly allowable. Applicant therefore respectfully requests removal of the rejections of claim 1-6 on the ground of nonstatutory obviousness-type double patenting over U.S. Patent No. 6,804,787.

Applicant also provides a comparison below between rejected claim 7 of the instant application and claims 1 and 3 of the cited patent, in the same manner as provided above for claim 1 of the instant application.

Instant Application:

7. A method for creating a database of verified personal information comprising:

gathering information regarding an individual;

presenting said information over a wide area computer network to said individual to review and verify said information's accuracy;

accepting commentary on the accuracy of said information based on said review from said individual over the wide area computer network;

including said commentary in said database with said information;

receiving a request over said wide area computer network from an authorized individual to review selected portions of said information;

presenting said request to said individual for authorization;

presenting said selected portions of said information over said wide area computer network to said authorized individual; and

providing access to said database and said commentary to third parties.

Patent 6,804,787

1. In a system that includes a computer device, a method for managing healthcare data in compliance with regulated privacy, security, and electronic transaction standards, the method comprising:

receiving from a requestor a request for healthcare information relating to a patient, wherein any request is received through a single point of entry regardless of whether the request is from a requestor internal or external to a given healthcare facility;

retrieving the requested healthcare information;

assembling a report, wherein the report includes:

the requested healthcare information;

any comments of the patient received at a gatekeeper system regarding the requested healthcare information; and

an audit trail; and

transmitting a copy of the report to the requestor through a single point of exit regardless of whether the request was from a requestor internal or external to the given healthcare facility.

3. A method as recited in claim 1, further comprising the step for determining whether patient authorization exists for responding to the request, wherein if authorization from the patient has not been obtained, performing the step for obtaining authorization from the patient to provide the requested healthcare information.

As may be readily appreciated from the above comparison, there are significant differences between the claimed invention of claim 7 from the instant application and claim 1 of

the cited patent. Specifically, claim 7 of the instant application recites a method for creating a database of verified personal information, while claim 1 of the cited patent claims a method for managing healthcare data in compliance with certain standards, and does not recite creating a database of verified personal information. Indeed, claim 7 of the instant application requires gathering information regarding an individual and presenting the information over a wide area computer network to the individual to review and verify the information's accuracy. In contrast, no such gathering of information and presentation of information to the concerned individual for verification of accuracy are disclosed in claims 1 or 3 of the cited patent.

The Office Action makes no showing of any correspondence between the recited limitations of claim 7 and any claim from the cited patent. Therefore, for at least these reasons, Applicant respectfully submits that claim 7 of the instant application is not anticipated or made obvious by the claims of the cited patent as the invention claimed by claim 7 of the instant application provides a method for gathering and verifying personal information to create a database of verified personal information. Such limitations are not claimed by any of the claims of the cited patent. Claims 8-13 of the instant application add additional limitations to claim 7 of the instant applications, and are therefore similarly allowable. Applicant therefore respectfully requests removal of the rejections of claim 7-13 on the ground of nonstatutory obviousness-type double patenting over U.S. Patent No. 6,804,787.

Rejections under 35 U.S.C. § 103(a):

In the Office Action, claims 1-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shelton in view of Coleman and claims 7-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shelton in view of Adams. M.P.E.P. § 2141 sets forth the

Graham factual enquiries that should be considered when making an obviousness rejection under Section 103: “Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.” (Citing *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).) Additionally, one helpful standard for a Section 103 rejection is set forth in M.P.E.P 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(Emphasis added). Applicant respectfully submits that the references cited by the Examiner, either alone or in combination, do not teach or suggest all the limitations claimed in the claim set provided herein. Applicant also respectfully submits that there is no suggestion or motivation to combine the references in the manner suggested in the Office Action, and that one of skill in the art would not reasonably expect success in combining the references in the manner provided. Therefore, Applicant respectfully submits that the differences between the cited references and the claimed invention show that the claimed invention is not made obvious by the cited references.

Regarding claims 1-6:

Claims 1-6 were rejected over Shelton and Coleman. Independent claim 1, as amended, requires: “A method for controlling a release of personal information comprising: depositing

some personal information regarding an individual with an enterprise/server; obligating organizations that possess additional personal information regarding said individual to not disclose that additional personal information without authorization from said enterprise/server; and instructing said enterprise/server to not release said some personal information held on the enterprise/server and to not authorize release of said additional personal information at the obligated organizations without receiving authorization from said individual.” Applicant respectfully submits that such limitations are not taught by the cited references, either alone or in combination.

Shelton discloses an internet based database search system for conducting searches of confidential records and for automating the process of obtaining approvals to make the records available. (Abstract) The system accesses a database containing medical data. (Col 4 lines 1-2) However, the database containing medical data is the only database of information disclosed in Shelton. Shelton therefore fails to teach the limitations of “obligating organizations that possess additional personal information regarding said individual to not disclose that additional personal information without authorization from said enterprise/server,” and “instructing said enterprise/server to not release said some personal information held on the enterprise/server and to not authorize release of said additional personal information at the obligated organizations without receiving authorization from said individual.” The organizations recited in column 9 lines 9-18, column 9 lines 57-63, and Figure 1 elements 10a-10c are all “users requiring access” to the confidential information (see Col 9 lines 12-13), and therefore cannot be said to be organizations possessing additional personal information as is required by claim 1. Since no such organizations are disclosed in Shelton, Shelton fails to teach the limitations recited in claim 1.

Coleman also fails to teach such limitations. Coleman teaches a system that provides privacy notices regarding an individual's personal information to various third parties. (Abstract) However, the interaction with third parties is entirely limited to two basic interactions. First, sending notices to the third parties requesting that no disclosure occurs. (Para [0059]) Second, personal information may be sold or given to third parties with permission from the individual (Para [0044]), but such transactions are disclosed as occurring entirely from a centralized information trust (Para [0079], see also "Data Flow" on Figures 7-9 from "Information Trust" labeled 300). Therefore, Coleman fails to teach the recited claim limitation regarding obligating, as Coleman merely teaches a notice instructing other organizations to not disclose any information in any form, and does not obligate organizations possessing additional personal information to not disclose the information without authorization from an enterprise/server. Coleman also fails to teach the claim limitation regarding instructing said enterprise/server, as Coleman only teaches a release of information from a single repository, and therefore does not teach instructing the enterprise/server to not authorize release of the additional personal information at the obligated organizations without receiving authorization from the individual.

Therefore, for at least these reasons, Applicant respectfully submits that the cited references, either alone or in combination, fail to disclose every element of claim 1. Applicant also respectfully submits that one of skill in the art would not combine the references in the manner suggested in the Office Action. Specifically, while both Shelton and Coleman deal with protecting individuals' privacy, the systems of Shelton and Coleman are directed to solving different problems and are essentially incompatible. The system of Shelton is directed to enabling sharing of already-confidential information such as patient records in such a way as to

ensure patient consent, enable searching of the information, and prevent unwanted disclosure of the already-confidential information. (See Col 1 lines 40-42 and 53-59, and see also Col 4 line 30-Col 8 line 18) In contrast, the system of Coleman is directed to obtaining control over individuals' information held by third parties and preventing sharing of that information that otherwise could be sold and shared by those third parties under existing law and practice. (See Para [0006]-[0011] and [0027]) Therefore, one of skill in the art would not be motivated to combine these differing and unrelated systems.

Therefore, claim 1 is not obvious in light of the cited references at least because of the limited scope of the cited art and because of the differences between the claim and the cited art. Claims 2-6 depend from claim 1 and are therefore allowable for at least the same reasons. Claim 3 is also allowable for additional reasons. Claim 3 requires "using WebCrawler programs to locate and retrieve publicly-available information regarding said individual from a plurality of Internet-accessible sources." Neither Shelton nor Coleman teach using WebCrawler programs that locate and retrieve publicly-available information regarding said individual from a plurality of Internet-accessible sources. Applicant therefore respectfully requests the removal of the rejections of claims 1-6 under 35 U.S.C. § 103(a) for at least the above reasons.

New claim 14 requires additional limitations that are not taught by Shelton or Coleman, and is therefore allowable for this additional reason.

Regarding claims 7-13:

Claims 7-13 were rejected over Shelton and Adams. Independent claim 7 requires:

A method for creating a database of verified personal information comprising: gathering information regarding an individual; presenting said information over a wide area computer network to said individual to review and verify said information's accuracy; accepting commentary on the accuracy of said

information based on said review from said individual over the wide area computer network; including said commentary in said database with said information; receiving a request over said wide area computer network from an authorized individual to review selected portions of said information; presenting said request to said individual for authorization; presenting said selected portions of said information over said wide area computer network to said authorized individual; and providing access to said database and said commentary to third parties.

The limitations of claim 7 are not taught by the cited references, either alone or in combination.

The Office Action indicated that Shelton does not teach the claim limitations of “presenting said information over a wide area computer network to said individual to review and verify said information’s accuracy,” “accepting commentary on the accuracy of said information based on said review from said individual over the wide area computer network,” and “including said commentary in said database with said information.” Applicant agrees; however, Applicant respectfully disagrees with the assertion in the Office Action that Adams teaches such limitations.

Adams teaches a patient test result delivery system. (Abstract) In the system of Adams, the patient may access the system, and may update the patient’s profile. (Para [0109]) However, nothing in Adams teaches receiving or accepting commentary on the accuracy of information, including said commentary in the database, and “providing access to said database and said commentary to third parties,” as is required by claim 7. The Office Action relies on Adams’ teaching of a checking of a release box as teaching accepting commentary. Applicant respectfully disagrees. The checking of a release box is clearly disclosed in Adams as permitting a certain physician to see certain test results that the physician otherwise would not be able to see. (Para [0118]) Nothing in Adams teaches or suggests that releasing the information to the physician should be equated with providing commentary on the accuracy of any information. In

other words, the release of information does not correspond to commentary on the accuracy of information.

Therefore, Adams fails to teach the limitations of claim 7 that are not taught by Shelton. Therefore, claim 7 is not made obvious by the cited references given the differences between the claims and the cited references. Claims 8-13 depend from claim 7 and are at least allowable for the same reasons. Additionally, claim 9 contains similar limitations discussed above with respect to claim 3 that are not taught by either of Shelton or Adams. Applicant respectfully submits that claim 9 is further allowable for this additional reason. Applicant therefore respectfully requests the removal of the rejections of claims 7-13 under 35 U.S.C. § 103(a) for at least the above reasons.

New claim 15 contains similar but more narrow limitations to those discussed above with respect to claim 7, and is therefore similarly allowable along with its dependent claims 16-20.

CONCLUSION

Applicant submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 23 day of October, 2007.

Respectfully submitted,


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